UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte BRENT C. PARENT, ANDY F. SUHY, Jr. AARON J. ROTH, and
PATRICK O'BRIEN

_____

Appeal 2009-5666
Application 09/504,000
Technology Center 3600

_____

Decided: April 29, 2010

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Before, MURRIEL E. CRAWFORD, HUBERT C. LORIN and
JOSEPH A. FISCHETTI, *Administrative Patent Judges.*

FISCHETTI, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 1, 2, and 22. Claims 3-15 have been objected to, but would be allowable if re-written in independent form. Claims 16-21 have been allowed.

We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM IN PART.

THE INVENTION

Appellants claim a system and method for use in the field of asset management and electronic commerce. (Specification 1:14-15)

Claim 1, reproduced below, is representative of the subject matter on appeal.

1. An electronic system for modeling a simulated fleet comprising:
a simulated fleet configuration unit configured to allow a user to add one or more assets to said simulated fleet, each asset having a parameter associated therewith;
a reporting and analysis module configured to generate a report having a composite output that corresponds to said parameter and is characteristic of all of said assets in said simulated fleet; and
a communications interface configured to facilitate electronic remote access of said system by the user.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Pisula   WO 99/06934   Feb. 11, 1999

The following rejection is before us for review.

The Examiner rejected claims 1, 2 and 22 under 35 U.S.C. § 102(a) as anticipated by Pisula.

ISSUE

Have Appellants shown that the Examiner erred in rejecting claims 1, 2 and 22 on appeal as anticipated by Pisula on the grounds that Pisula discloses a composite output that corresponds to a parameter and is characteristic of all assets in a simulated fleet by disclosing a report generator (Figure 7) which generates a report of physical specifications for equipment used to carry freight absent the independent claims requiring a summation or mathematical manipulation?

PRINCIPLES OF LAW

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987), *cert. denied*, 484 U.S. 827 (1987).

FINDINGS OF FACT

We find the following facts by a preponderance of the evidence:

1. Pisula discloses in Figure 7:

...a pictorial diagram of an UMLER dialog window

generated by the UMLER module ll6. The UMLER
module 116 provides a user with a means to acquire
physical specifications for equipment used to carry
freight. The specifications can be obtained by entering an
equipment initial and number or through a pool listing
that is maintained in the pool management module 112.
The user can view, print, and export the list as well as the
specifications received from the mainframe.

(Pisula, p. 7, ll. 1-7)
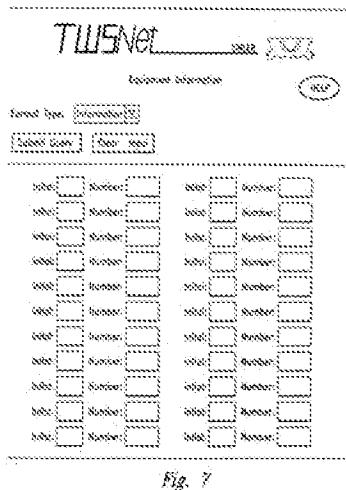
2. Figure 7 of Pisula is shown below:

Fig. 7

Figure 7 shown above illustrates a pictorial diagram of an UMLER dialog
window generated by the UMLER module ll6.

3. Pisula discloses "[a] Fleet Listing facility [that] provides the user with a
means to obtain a list of all of the equipment that is currently defined for a specific
pool or fleet, for a specific pool or fleet." (Pisula, p. 6, ll. 12-14)

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ANALYSIS

We affirm the rejection of claims 1 and 22 and reverse as to claim 2.

Appellants' arguments against the rejection of independent claims 1 and 22 are based on the same perceived deficiencies of Pisula. Inasmuch as Appellants raise the same issues with respect to each of these claims, we discuss them together, addressing each of Appellants' arguments in turn.

Appellants argue that the claimed "… composite output is the result of a summation or other mathematical manipulation that is not taught or suggested in the Pisula reference. The report of the Pisula reference is identified by the examiner as an inventory report, which is a mere listing of assets." (Appeal Br. 5-6) We disagree with Appellants given the breadth of the independent claims.

Independent claims 1 and 22 only require *a reporting and analysis module configured to generate a report having a composite output that corresponds to said parameter and is characteristic of all of said assets in said simulated fleet.* Pisula discloses that the report generator of Figure 7 generates a report of physical specifications for equipment used to carry freight. (FF 1-3) Nothing in the independent claims require a summation or mathematical manipulation as argued by the Appellants. Moreover, the dialog window generated by the UMEL module 116 has numerous entry fields for allowing the creation of composite or multiple listing of assets which compose an involved fleet (FF 2,3). Thus, Appellants' argument as to this point is not persuasive.

Appellants next argue "Claim 1 also requires 'a simulated fleet configuration unit configured to allow a user to add one or more assets to said simulated fleet.'

The Pisula reference does not show any simulated fleets and does not provide a system to change one." (Appeal Br. 7) Appellants however maintain that "[a] simulated fleet is defined in the Specification as containing '(i) any assets in any of the user's existing fleets ('held assets')....'" (Appeal Br. 8). Since Pisula discloses using the user's existing fleet as data for the UMEL system (FF 3), Pisula meets the claim requirements. Thus, Appellants' argument is unpersuasive.

Moreover, simply reciting a simulated fleet does not equate to generating fleet data from a model calculation, which model calculation does not appear in the body of the claims. *See Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.,* 868 F.2d 1251, 1257 (Fed. Cir. 1989) (An element initially recited in the preamble, is must be thereafter fully incorporated into the body of the claim so as to breathe life and breath into it by setting forth the complete combination).

Appellants argue that claim 22 distinguishes over Pisula because it recites a combination of pre-existing fleet assets and simulated assets. (Appeal Br. 11) Specifically, Appellants argue that:

> The underlying data that makes up the different fleets is *functionally* related to the respective fleets. The data provides the distinguishing characteristics for each fleet and therefore directly depends on the fleet make-up, and whether it is a real or a fantasy fleet. This is exactly the opposite situation from the inclusion of printed matter that teaches a new use for an exiting product, as argued in *In re Ngai* and as distinguished from *In re Gulack.*

(Appeal Br. 11). We disagree with Appellants because the argument assumes that the system is structured to discern pre-existing fleet assets from simulated assets when in fact claim 22, which is drawn to an apparatus, recites no such structure

which would effect this distinction. Without any such limitation, the issue is one of veracity of the data, which cannot further limit the structure of the device.

Claim 2 recites in pertinent part, *a fleet builder module, including a step-by-step asset entry system; a fleet search module including a first add-to-fleet feature; a simulated fleet module including an add-asset feature, and a market search module including a second add-to-fleet feature.* Appellants challenge the failure of Pisula to disclose these features. The Examiner's reply relies on his arguments set forth for claim 1. (Answer 6). However, claim 2 adds limitations to claim 1, e.g., *a market search module including a second add-to-fleet feature*, and therefore the argument is not effective. We thus cannot sustain the rejection of claim 2.

Deleted:

CONCLUSIONS OF LAW

We conclude the Appellants have not shown that the Examiner erred in rejecting claims 1 and 22.

We conclude the Appellants have shown that the Examiner erred in rejecting claim 2.

DECISION

The decision of the Examiner to reject claims 1 and 22 is AFFIRMED.

The decision of the Examiner to reject claim 2 is REVERSED.

<u>AFFIRMED-IN- PART</u>

JRG

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